

## **REMARKS**

Claims 44-57, 59-63, 65-84, and 86-98 are pending in the Application and all stand rejected in the Office action mailed August 26, 2010. Claims 63, 65-70, and 93-95 are amended and dependent claims 99-113 are added by this submission. Claims 44, 63, and 71 are independent claims from which claims 45-62 and 90-92, claims 64-70 and 93-95, and claims 72-89 and 96-98 depend, respectively. Applicants respectfully request reconsideration of pending claims 44-57, 59-63, 65-84, and 86-89, and consideration of new dependent claims 99-113, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

As an initial matter, Applicants respectfully note that claims 50-52, 77-79, 92, 95, and 98 are not rejected over any of the cited art.

### **Amendments to Claims**

Claims 63, 65-70, and 93-95 have been amended to add the term “non-transitory” at the suggestion of the Office. Applicants respectfully submit that these amendments do not add new matter.

### **Rejections of Claims**

Claims 63, 65-70, and 93-95 were rejected under 35 U.S.C. §101. Claims 50-52, 77-79, 92, 95 and 98 were rejected under 35 U.S.C. §112, first paragraph. Claims 44, 47-49, 53-61, 63, 64, 67-69, 71, 74-76, 80-88, 90, 93, and 96 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal, *et al.* (US 4,723,238, “Isreal”) in view of Suffern, *et al.* (US 5,724,413, “Suffern”) and Barberis, *et al.* (US 4,317,195, “Barberis”). Claims 45, 46, 65, 66, 72 and 73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Row, *et al.* (US 5,163,131, “Row”). Claims 62, 70 and 89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Messenger (US 5,046,066). Claims 91, 94 and 97 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Nishimoto (US 4,549,297). Applicants respectfully traverse the rejections for the reasons set forth during prosecution, and those that follow.

#### **I. Claims 63, 65-70, And 93-95 Are In Compliance With 35 U.S.C. §101**

Claims 63, 65-70, and 93-95 were rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully traverse the rejection. Nevertheless, Applicants have amended claims 63, 65-70, and 93-95 as suggested by the Office solely to further the Application towards allowance. Applicants respectfully submit that the rejection of claims 63, 65-70, and 93-95 under 35 U.S.C. §101 is thereby overcome, and respectfully request that the rejection of claims 63, 65-70, and 93-95 under 35 U.S.C. §101 be reconsidered and withdrawn.

## **II. Claims 50-52, 77-79, 92, 95 And 98 Are Rejected Under 35 U.S.C. §112, 1st¶**

Claims 50-52, 77-79, 92, 95 and 98 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

**With regard to claims 50-52 and 77-79**, the Office asserts, in part, the following:

Claims 50 and 77, in tandem with parent claims 44 and 71, recite "...the communication including the conversion of information received in a packet format for transmission in the associated format, and the conversion of information received in the associated format for transmission in the packet format, wherein the conversion of information received in a packet format for transmission in the associated format comprises buffering digitized voice information for a period of time to minimize gaps in a voice signal...wherein the at least one communication network is a second packet network"; however, the specification teaches that if setup assistance is not needed, the access device merely forwards the call setup packet to the destination device (**see fig. 59 and p. 299 lines 4-6**), and source and destination devices themselves generate voice packets (**p. 300 lines 8-12**). Thus, the specification does not teach the access device performing conversion between two packet networks. Claims 51, 52, 78 and 79 inherit this deficiency.

(emphasis in original)

The Office cites Applicants' specification at page 299, lines 4-6 and FIG. 59 as supporting the assertion by the Office that "...the specification does not teach the access device performing conversion between two packet networks." Applicants respectfully disagree. As is seemingly recognized by the Office, page 299, lines 4-6 of the specification state "[i]f setup assistance is not needed, the access device merely forwards the call setup packet to the destination device." There are at least two errors of logic present in the argument of the Office.

First, the identified sentence from the specification relates to a "call setup packet," not a "voice packet," as claimed, and therefore the Office has not identified a teaching with regard to handling of a "voice packet."

Second, the stated forwarding of the “call setup packet” occurs “[i]f setup assistance is not needed.” The Office has not shown how and why “setup assistance is not needed,” and therefore fails to even establish that the condition for forwarding of the erroneously identified “call setup packet” is somehow met by the language of “[c]laims 50 and 77, in tandem with parent claims 44 and 71.” In addition, Applicants respectfully submit that the specification at cited page 300, lines 8-12 fails to support this argument of the Office, in that the cited portion of the disclosure simply states “if it has the capability of performing the packetization processing, a source or destination device connected directly to a wired or wireless network will generate call voice packets for delivery through the network,” which is not a statement that conversion does not occur. Applicants’ specification discloses, for example at page 258, lines 16-20 that “[v]oice signals traveling through the telephone switching network (not shown ) may either remain in a continuous, nonpacketized form (herein a “voice stream”) as captured, for example, by a microphone, or be routed as voice packets using known modem technology,” which Applicants respectfully submit would be recognized by one of ordinary skill in the relevant art at the time of the invention to involve conversion, for at least the reason that the “first packet network” and “second packet network” may not operate at the same speed. Further, Applicants respectfully submit that a “modem” may be considered to perform “conversion.” Thus, Applicants respectfully submit that the statement by the Office that “...the specification does not teach the access device performing conversion between two packet networks,” is false.

**With regard to claims 92, 95, and 98**, the Office asserts, in part, that “the specification does not describe using the propagation delay to determine the buffering period of time during the communication of voice.” See August 26, 2010 Office action at page 4. Applicants respectfully disagree. For example, Applicants respectfully submit that adequate support is disclosed, at least, at page 285, lines 2-7, which states, in part, “...round trip test signals are interspersed with voice packets and decisions made regarding queuing times and full or half duplex considerations are reevaluated for further voice session support.” Applicants respectfully submit that one of ordinary skill in the relevant art at the time of the invention would, having read and appreciated at

least that portion of Applicants' disclosure, understand that the Specification of the Application teaches, at least, "using the propagation delay to determine the buffering period of time during the communication of voice." Therefore, Applicants respectfully submit that the assertion that "the specification does not describe using the propagation delay to determine the buffering period of time during the communication of voice," as asserted by the Office, is false.

Therefore, based at least upon the above, Applicants respectfully submit that claims 50-52, 77-79, 92, 95, and 98 are in compliance with 35 U.S.C. ¶112, first paragraph, and respectfully request that the rejection of claims 50-52, 77-79, 92, 95, and 98 under 35 U.S.C. ¶112, first paragraph, be reconsidered and withdrawn.

Applicants respectfully note that all of the rejections over art are for reasons of alleged obviousness, and that the Office has not established a *prima facie* case of obviousness with respect to any of the pending claims. Applicants first review what is required to support a rejection under 35 U.S.C. §103. According to M.P.E.P. §2142, **"[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.** If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." (emphasis added) M.P.E.P. §2142 further states that **"[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious."** (emphasis added) As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that **the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.**" (emphasis added) In addition, the Federal Circuit has made clear that "rejections on obviousness **cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396. (emphasis added)

In addition, as noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), “[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP §2143.03. Further, “[**all words in a claim** must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” *Id.*

Thus, the law is clear that **words of a claim cannot be merely disregarded during examination**. Instead, **all** the words in a claim **must** be considered during the examination process.

Further, in *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

*Ex parte Hiyamazi*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988) (emphasis added).

Applicants respectfully submit that the pending claims are allowable for at least the reasons set forth during prosecution, and those that follow.

### **III. The Proposed Combination Of Isreal, Suffern And Barberis Does Not Render Claims 44, 47-49, 53-61, 63, 64, 67-69, 71, 74-76, 80-88, 90, 93, And 96 Unpatentable**

Claims 44, 47-49, 53-61, 63, 64, 67-69, 71, 74-76, 80-88, 90, 93, and 96 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern and Barberis. Applicants respectfully traverse the rejection.

**With regard to independent claim 44**, Applicants respectfully submit that claim 44 recites, in part, “[a] method for communicatively coupling a packet network to at least one communication network having an associated information format,” the method comprising “providing, to a host device, at least a portion of the information requesting setup of a call,” and “receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call.” Independent claim 71 recites language similar to claim 44. Applicants respectfully submit that claims 44 and 71 were rejected over the same art for the same reasons. Applicants respectfully submit that the proposed combination of Isreal, Suffern, and Barberis does not teach, suggest, or disclose all aspects of claims 44 and 71, and therefore does not render those claims, or any of the claims that depend from claims 44 and 71, unpatentable.

In rejecting claims 44 and 71, the Office states, in part, the following:

Isreal does not teach providing, to a host device, at least a portion of the information requesting setup of a call; receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call. However, Suffern from a similar field of endeavor teaches an interface card that provides received signals to the host device for processing (Suffern: figs. 1-4). It would have been obvious to modify Isreal [] incorporate Suffern's teaching in order to reduce the cost of the interface card and to facilitate revision without requiring hardware modification.

Thus, the Office once again vaguely relies on FIGs. 1-4 of Suffern, and fails to specifically identify any elements of FIGs. 1-4, or any text from Suffern, to support the conclusory statement that Suffern teaches “an interface card that provides received signals to the host device for processing.” This assertion by the Office fails to provide the support required for establishment of a *prima facie* case of obviousness for a number of reasons. Initially, Applicants respectfully submit that this statement does not even address the language of the claim that states “receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call,” and the language of the rejection does not assert that Barberis provides any support for this aspect of Applicants’ claim 44. Second, the Office has not identified the elements of Suffern that allegedly teach “configuration information” received from a “host device,” and has not demonstrated where Suffern teaches that the “configuration information” is based upon the claimed “at least a portion of the information requesting setup of a call.”

As previously discussed above, M.P.E.P. §2142 states that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness,” that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit,” and that “rejections on obviousness **cannot be sustained with mere conclusory statements;** instead, there **must** be some **articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**”

Applicants respectfully submit that the Office admits that Isreal does not teach “providing, to a host device, at least a portion of the information requesting setup of a call,” **and** “receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call,” and the Office has not demonstrated that either Suffern or Barberis teach, at least, “receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call.” Therefore, Applicants respectfully submit that the Office has not demonstrated that the proposed **combination of Isreal, Suffern, and Barberis** teaches, suggests or discloses at least this aspect of Applicants’ claim 44, that the Office has not met the requirements of M.P.E.P. §2142, and that the cited does not



render claim 44 unpatentable. Applicants respectfully submit that claim 71 is rejected based upon the same art using the same arguments set forth in the rejection of claim 44, and therefore is also not rendered unpatentable over the cited art

Additionally, referring to the PTO's published guidelines of October 10, 2007, with regard to the procedure to be followed by Examiners when making an obviousness rejection, the guidelines recite **seven rationales** supporting an obviousness rejection and give specific findings that **must be made** by an Examiner in order for the Examiner to use the rationale to support a finding of obviousness. These findings are **not optional and must be articulated by the Examiner for the rationale to apply**. The seven rationales are listed below.

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

MPEP at § 2141.

If the current rejections are maintained, the Applicants respectfully request that the Examiner's Answer: 1) **identify the specific Rationale** (i.e., by specifically indicating one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejections so that the Applicants may more clearly address the Examiner's concerns, and 2) **state on the record** the **required** factual findings to support the Rationale that the Examiner has chosen.<sup>1</sup> Failure to specifically identify the specific rationale and state the required factual findings will seemingly be a tacit admission that the Examiner is unable to satisfy the **required** factual findings.

"It is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in KSR and discussed in the 2007 KSR Guidelines, they are to adhere to the instructions provided in the MPEP regarding the **necessary** factual findings." See September 1, 2010 Examination Guidelines Update (emphasis added).

Further, it is "Office policy that appropriate factual findings are **required** in order to apply the enumerated rationales properly. If a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel **must** either withdraw the rejection, or repeat the rejection including all the required factual findings." See *id.* (emphasis added).

Again, it is not enough to simply conclude that a claim is obvious while acknowledging that the cited references fail to disclose particular limitations. See *In re Vaidyanathan*, at pages 18-19. "[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to **some concrete evidence in the record in support of these findings.**" See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

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<sup>1</sup> Indeed, the Applicants respectfully request such an explicit analysis and associated factual findings for each and every rejection under 35 U.S.C. §103 of any of the pending claims, as **required** by current PTO practice.

For at least these reasons, the Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claims 44 and 71 and the claims depending therefrom.

**With regard to claims 50-52**, Applicants respectfully submit that the Office did not reject claims 50-52 over the cited art, and that those claims are allowable over the cited art for at least that reason. In addition, claims 50-52 depend from claim 44, which Applicants have demonstrated is allowable over the cited art. Therefore, claims 50-52 are also allowable as being dependent from allowable claim 44.

**With regard to independent claim 71**, Applicants respectfully submit that claim 71 was rejected over the same art as claim 44, for the same reasons. Applicants respectfully submit that claim 71 is therefore allowable over the cited art for at least some of the reasons set forth above with respect to claim 44.

**With respect to claim 77**, Applicants respectfully submit that the Office did not assert a rejection of claims 77-79 over the cited art. Therefore, Applicants believe that claims 77-79 are allowable over the cited art for at least that reason. In addition, claims 77-79 depend from claim 71, which Applicants have demonstrated is allowable over the cited art. Therefore, claims 77-79 are also allowable as being dependent from allowable claim 71.

**With regard to independent claim 63**, Applicants respectfully submit that claim 63 recites features similar to claims 44 and 71, that claim 63 is rejected over the same art as claims 44 and 71, and that claim 63 is therefore allowable over the cited art for at least some of the reasons set forth above.

Based at least upon the above, Applicants respectfully request that the rejections of claims 44, 63, and 71, and their respective dependent claims 44, 47-49, 53-61, 63, 64, 67-69, 71, 74-76, 80-88, 90, 93, and 96 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **IV. The Proposed Combination Of Isreal, Suffern, Barberis, And Row Does Not Render Claims 45, 46, 65, 66, 72, And 73 Unpatentable**

Claims 45, 46, 65, 66, 72 and 73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Row, *et al.* (US 5,163,131, "Row"). Applicants respectfully traverse the rejection.

Applicants respectfully submit that claims 45 and 46, claims 65 and 66, and claims 72 and 73 depend, respectively, from independent claims 44, 63, and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Row overcomes the admitted and demonstrated shortcomings of Isreal, Suffern, and Barberis, discussed above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 45, 46, 65, 66, 72, and 73 that depend from claims 44, 63, and 71 are also allowable over the proposed combination of art, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 45, 46, 65, 66, 72, and 73 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **V. The Proposed Combination Of Isreal, Suffern, Barberis, And Messenger Does Not Render Claims 62, 70, And 89 Unpatentable**

Claims 62, 70 and 89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Messenger (US 5,046,066). Applicants respectfully traverse the rejection.

Applicants respectfully submit that claims 62, 70, and 89 depend, respectively, from independent claims 44, 63, and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Messenger overcomes the admitted and demonstrated shortcomings of Isreal, Suffern, and Barberis, set forth above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 62, 70, and 89 that depend from claims 44, 63, and 71 are also allowable over the proposed

combination of art, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 62, 70, and 89 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **VI. The Proposed Combination Of Isreal, Suffern, Barberis, And Nishimoto Does Not Render Claims 91, 94, And 97 Unpatentable**

Claims 91, 94 and 97 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Nishimoto (US 4,549,297). Applicants respectfully traverse the rejection.

Applicants respectfully submit that claims 91, 94, and 97 depend, respectively, from independent claims 44, 63, and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Nishimoto overcomes the admitted and demonstrated shortcomings of Isreal, Suffern, and Barberis, set forth above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 91, 94, and 97 that depend from claims 44, 63, and 71 are also allowable over the proposed combination of art, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 91, 94, and 97 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **Newly Added Claims**

New claims 99-113 have been added. Claims 99-103, 104-108, and 109-113 depend, directly or indirectly, from independent claims 44, 63, and 71, respectively. Applicants respectfully submit that support for claim 99-113 may be found, for example, at pages 271 to 289 of the Application. Applicants respectfully submit that new claims 99-113 do not add new matter, and are allowable for at least the reasons set forth above.

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### **Conclusion**

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of the pending claims are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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